

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 2, 5, 7-11, and 13-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,070,143 to Barney et al. ("Barney") and rejected claims 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Barney in view of U.S. Patent No. 6,213,780 to Ho et al. ("Ho"). Claims 1, 2, 5, 7-11, 13-18, and 20 remain pending and under examination.

I. Rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, 5, 7-11, and 13-17 under 35 U.S.C. § 102(b) as being anticipated by Barney. In order to properly establish that Barney anticipates Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Barney fails to teach each and every element recited in independent claim 1. In particular, Barney does not disclose a method including, among other things, "creating one or more role analysis profiles . . . wherein each of the role analysis profiles are organized to comprise a list of at least one **core task**, a list of at least one **formal training requirement**, a list of at least one **process knowledge requirement**, a list of

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Office Action.

at least one **technical knowledge requirement**, and a list of at least one **problem solving skill**,” as recited in claim 1 (emphasis added).

The Examiner’s reference to Col. 6, lines 55-59 in Barney does not teach or suggest “creating one or more role analysis profiles . . . wherein each of the role analysis profiles are organized to comprise a list of at least one **core task**, a list of at least one **formal training requirement**, a list of at least one **process knowledge requirement**, a list of at least one **technical knowledge requirement**, and a list of at least one **problem solving skill**,” as recited in claim 1 (emphasis added). That section of Barney states that once “subject matter experts have completed [a] preliminary survey . . . [a] job analysis wizard 100 allows the analyst to determine dimensions that are critical to the job.” However, there is no mention of creating profiles which include “a list of at least one **core task**, a list of at least one **formal training requirement**, a list of at least one **process knowledge requirement**, a list of at least one **technical knowledge requirement**, and a list of at least one **problem solving skill**,” as recited in claim 1 (emphasis added). Merely stating that the “job analysis wizard 100 allows the analyst to determine dimensions that are critical to the job” does not imply that the dimensions include a “core task,” a “formal training requirement,” a “process knowledge requirement,” a “technical knowledge requirement,” and a “problem solving skill.” These elements are completely absent in Barney.

For at least this reason, independent claim 1 is allowable over Barney. Claims 2, 5, 7-11, and 13-17 are allowable over Barney at least due to their dependence from claim 1.

II. Rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Barney in view of Ho. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art taken separately or in combination must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, the prior art, taken alone or in combination, do not teach or suggest each and every element of Applicants’ independent claim 1 and required by dependent claims 18 and 20. As discussed above, Barney fails to teach or suggest a method including “creating one or more role analysis profiles . . . wherein each of the role analysis profiles are organized to comprise a list of at least one **core task**, a list of at least one **formal training requirement**, a list of at least one **process knowledge requirement**, a list of at least one **technical knowledge requirement**, and a list of at least one **problem solving skill**,” as recited in claim 1 (emphasis added), and required by claims 18 and 20. Ho fails to cure the deficiencies of Barney.

Ho is cited by the Examiner for allegedly teaching “determining skill gaps in the organization based on the one or more final role analysis profiles” (claim 18) and

"wherein determining skill gaps comprises: receiving data on an individual's qualifications" (claim 20). Office Action, pages 7-8. Such alleged teachings, even if combinable with Barney, fail to cure the noted deficiencies of Barney. That is, Ho also fails to teach or suggest a method including "creating one or more role analysis profiles . . . wherein each of the role analysis profiles are organized to comprise a list of at least one **core task**, a list of at least one **formal training requirement**, a list of at least one **process knowledge requirement**, a list of at least one **technical knowledge requirement**, and a list of at least one **problem solving skill**," as recited in claim 1 (emphasis added), and required by claims 18 and 20.

For at least the reason that the prior art, whether taken alone or in combination, fails to teach or suggest each and every element of independent claim 1, which are required by claims 18 and 20, a *prima facie* case of obviousness cannot be established with respect to these claims. Claims 18 and 20 should therefore be allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 18 and 20 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

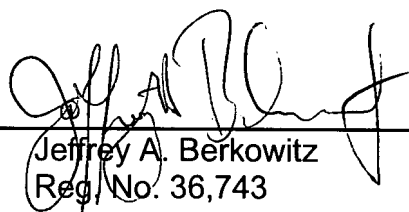
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: _____


Jeffrey A. Berkowitz
Reg. No. 36,743